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10/723,656

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Jose M. Sosa

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FINA TECHNOLOGY INC  
PO BOX 674412  
HOUSTON, TX 77267-4412

EXAMINER

ASINOVSKY, OLGA

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOSE M. SOSA and  
KENNETH PAUL BLACKMON

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Appeal 2007-4309  
Application 10/723,656  
Technology Center 1700

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Decided: March 14, 2008

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Before EDWARD C. KIMLIN, THOMAS A. WALTZ, and  
PETER F. KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2006) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

1 The appeal is from the Examiner's final rejection of claims 1-36, the only claims that remain pending in this application. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

Appellants' invention is directed to a co-polymerized product, a method of making same, a resin, and an article made from the resin. The products and product of the process are claimed to be characterized by a percent gel to percent rubber ratio (G/R) that increases as swell index increases.

A significant issue raised in the appeal with respect to the Examiner's applied obviousness rejection over each of five references is whether or not the applied references each discloses or suggests formation of a copolymerized product or resin having the claimed G/R to swell index characteristic.

Appellants have proffered evidence, including technical evidence in the form of a U.S. Patent (U.S. Pat. No. 6,703,460) and an article by E.R. Wagner and L.R. Robeson, *Impact Polystyrene: Factors Controlling the Rubber Efficiency*, Rubber Chem. Tech., 43, 1129-1137 (1970), as allegedly tending to establish the unobviousness of the claimed subject matter to an ordinarily skilled artisan (Br. 4; Reply Br. 2). While the Brief filed December 15, 2006 and the Reply Brief filed June 6, 2007 refers to this evidence in support of the arguments furnished against the Examiner's obviousness rejections, and the Brief includes an Evidence Appendix listing

this evidence, the Evidence Appendix does not furnish a statement as to the entry of this evidence in the record by the Examiner as required (*see* 37 C.F.R. § 41.37(c) (ix)) or clearly indicate that a copy of the evidence accompanied the Brief, as required.

The Examiner does not acknowledge this evidence in the Examiner's Answer mailed April 18, 2007, much less furnish a specific rebuttal based on the merits of Appellants' arguments relying on such evidence, to the extent that evidence is of record.

On the other hand, the Examiner has not furnished Applicants with an appropriate Notification of any entry issue regarding the evidence pursuant to 37 C.F.R. § 41.37(d); such as for a lack of the requisite statement of the Examiner's previous entry of the evidence and/or for the lack of a copy thereof, and/or for a non-entry rationale under § 41.41(b), if such were applicable.

We decline to speculate as to the entry status of the above-identified evidence, on this record. Thus, our review of the record of this application reveals that this appeal is not in condition for a decision at this time.

Moreover, the Examiner basically takes the position that claimed swell index increase (with G/R increase) will occur in each of the applied references' products using a multifunctional initiator as claimed "in the absence of evidence to the contrary" (Ans. 8). Thus, the Examiner fails to offer the requisite analysis and commentary on the substance of the evidence relied on by Appellants in the Briefs, to the extent that evidence is determined to have been properly submitted for consideration on appeal, as is required so that a reasoned Decision can be reached by a Board panel taking any entered evidence submitted by Appellants into account.

Accordingly, we remand the application to the Examiner, via the Office of the Director of the Technology Center, to consider the foregoing issues and to take action not inconsistent with the views expressed herein. In this regard, the application is remanded to the Examiner for clarification of the appeal record, as to the Examiner's entry of any properly submitted evidence relied upon by Appellants, and for the purpose of placing on record the Examiner's substantive analysis of any evidence that has been properly submitted by Appellants for review on appeal.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REMANDED

tf/ljs

FINA TECHNOLOGY INC.  
P.O. BOX 674412  
HOUSTON, TX 77267-4412